

Appl. No. 09/745,702
Attr. Docket No. 8384
Amdt. dated January 30, 2004
Reply to Office Action of Oct. 30, 2003
Customer No. 27752

REMARKS

Claims 1, 6-10 and 12-20 are pending in the present application. Claim 3 has been cancelled and claims 12-20 have been withdrawn from consideration. No additional claims fee is believed to be due.

Claim 1 has been amended to include the limitations of claim 3, to correct a transcriptional error, to correct antecedent basis issues, and to eliminate redundancy of claim limitations. Claims 6 and 8 have been amended to correct antecedent basis issues. Similarly, claim 10 has been amended to include the limitation of a length of flexible tubular sheet, to correct a transcriptional error, to correct antecedent basis issues, and to eliminate redundancy of claim limitations. Support for both of these amendments can be found in the claims as originally filed.

Non-statutory Double Patenting

The Office Action has provisionally rejected claims 1, 3, and 6-10 "under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1, 2, 5-8, 11, 13-16, and 18 of copending Application No. 10/01,391. Applicants will submit a terminal disclaimer in accordance with 37 C.F.R. § 1.321(c) concerning the double patenting rejection received on Application No. 10/01,391.

Rejection Under 35 USC 103(a) Over Lecomte in view of Hamilton et al.

Claims 1, 3, and 6-10 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,065,272 issued to Lecomte in view of U.S. Patent No. 5,662,758 issued to Hamilton et al. The Office Action asserts that Lecomte "discloses the claimed invention, but does not expressly disclose that the tubular sheet comprises the adhesive material." The Office Action asserts that the Hamilton et al. reference discloses a flexible film having a pressure sensitive adhesive which is protected from inadvertent adherence and that the combination of these two reference renders the claimed invention obvious. Applicants respectfully traverse the rejection of the Office Action because the Office Action fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references

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must teach or suggest all of the claim limitations. *Id.* The Office Action fails to establish a *prima facie* case of obviousness because there is no motivation to combine the cited references.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *See United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). The Lecomte reference teaches a pair of welding pliers as the primary mode for sealing the sleeve. (*See* col. 4, lines 25-30, lines 36-40, lines 42-45, and lines 52-55). When the pair of welding pliers is omitted, the Lecomte reference teaches that "the constant pressure of the rollers on the sleeve allows an already consequent confinement." (col. 4, lines 55-59). Because the Lecomte reference teaches that an adequate seal is created via the welding process or in the absence of the welding process, via the constant pressure of the rollers, one skilled in the art would be led in "a direction divergent from the path that was taken by the" Applicants. Specifically, one skilled in the art would not think about whether an adhesive should be added to the sleeve because even in the absence of its primary sealing mechanism, the constant pressure of the rollers creates "an already consequent confinement." (*Id.*) Thus, the Lecomte reference teaches away from any suggested combination with Hamilton et al. and therefore, there is no motivation or suggestion to combine the cited references.

The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). In the Mills case, the claimed invention was directed toward an apparatus for producing an aerated cementitious composition. *In re Mills*, 916 F.2d at 681. The composition was created by driving air into an output pump at a rate that was greater than the feed rate of the pump. *Id.* The cited prior art reference taught that the speed of the prime mover could be controlled by a variable speed transmission. *Id.* at 682. The court found that the teachings of the prior art reference were inadequate to establish a *prima facie* case of obviousness because the cited reference did not require the output pump to run at the claimed speed. *See Id.*

Similar to the Mills case cited above, the Lecomte teaches a device for packaging articles in a sleeve, wherein the article is driven into the sleeve by rollers, and **tight closure of the sleeve is effected as desired.** (emphasis added)(col. 2, lines 5-10). However, the Lecomte reference while stating that tight closure of the sleeve may be effected as desired, does not require that the sleeve comprise an adhesive to accomplish the sealing of the sleeve nor does it make any mention of creating a better seal via a different process. Because the Lecomte reference makes no

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recommendation or suggestion on how to improve the sealing of the sleeve, the Lecomte reference does not provide any suggestion or motivation to make the cited combination with the Hamilton et al. reference.

Last, "[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." MPEP § 2142. The level of skill in the art cannot be relied upon to supply the motivation to combine the cited references. MPEP § 2143.01 (citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)). Even if the cited references teach all aspects of the claimed invention and are individually known in the art, that is not sufficient to establish a *prima facie* case of obviousness without an objective reason to combine the cited references. *Id.* (citing *Ex parte Levengood* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

After discussing the various aspects of the claimed invention taught by the cited references, the Office Action provides that "it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Lecomte's tubular sheet by applying the flexible film with adhesive as taught by Hamilton." (page 3, item 9). Because the Office Action has not provided any objective evidence of a reason to combine the cited references and instead relies upon the skill in the art to provide the motivation to combine the references, Applicants assert that the obviousness rejection is improper.

Because there is no suggestion or motivation to combine the cited references, the Office Action has not established a *prima facie* case of obviousness. Because the Office Action has not established a *prima facie* case of obviousness, Applicants assert that claims 1 and 6-10 are non-obvious and are in condition for allowance.

Rejection Under 35 U.S.C. 103(a) Over Richards et al. in view of Hamilton et al.

The Office Action has rejected claims 1, 3, and 6-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et al. in view of U.S. Patent No. 5,662,758 issued to Hamilton et al. Applicants respectfully traverse the rejection by the Office Action because there is no motivation to combine the cited references thereby precluding the Office Action from establishing a *prima facie* case of obviousness.

The Richards et al. reference teaches a packaging device which utilizes pleated tubing to package articles. (Abstract). The Richards et al. reference teaches several methods for sealing the pleated tubing. First the Richards et al. reference teaches that the top of the pleated tubing is pulled upward and tied into a knot thereby forming the bottom of the package. (col. 3, lines 11-

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14). Second, the Richards et al. reference teaches that after the articles are placed within the tubing, the tubing is twisted such that a seal is formed. (col. 3, lines 55-60). Third, even if the intermediate twisted seals become loose, the topmost twisted seal prevents odors from escaping. *Id.* Fourth, the Richards et al. reference recommends the use of high density polyethylene because joints that are created using this material remain tight. *Id.*

In contrast, the Hamilton et al. reference teaches a three dimensional film having adhesive thereon. Thus, the sealing methods taught by the Richards et al. reference teach away from the cited combination by the Office Action because one of ordinary skill in the art would be led in a direction divergent from the path taken by the Applicants. Specifically, one of ordinary skill in the art would not use the three dimensional film of Hamilton. Because the Richards et al. reference teaches a high density polyethylene for use in the tubing for maintaining tight seals, one of ordinary skill in the art would seek to use a high density polyethylene without an adhesive. Thus, the Richards et al. reference teaches away from any suggested combination with Hamilton et al., and therefore, there is no motivation to combine the cited references.

After discussing the various aspects of the claimed invention taught by the cited references, the Office Action similar to the previous conclusion provides that "it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Richard's tubular sheet by applying the flexible film with adhesive as taught by Hamilton." (page 7, item 11). Because the Office Action has not provided any objective evidence of a reason to combine the cited references and instead relies upon the skill in the art to provide the motivation to combine the references, Applicants assert that the obviousness rejection is improper. Therefore, the Office Action has not established a *prima facie* case of obviousness.

Because there is no suggestion or motivation to combine the cited references, the Office Action has not established a *prima facie* case of obviousness. Because the Office Action has not established a *prima facie* case of obviousness, Applicants assert that claims 1 and 6-10 are non-obvious over the cited combination and are in condition for allowance.

Response to Arguments

The Office Action asserts that the tubular sheet is a work piece being used with the apparatus and is therefore not considered as a structure limitation of the claim. Applicants respectfully traverse this assertion. Section 2115 of the MPEP provides that the line of cases which discuss work articles only applies to "machinery which works upon an article or material in its intended use." In the present case, the claimed packaging device does not work on the length

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of flexible tubular sheet. As amended, the length of flexible tubular sheet is an element of the packaging device. The only work piece evident in the present invention is the article to be packaged.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 and 6-10.

Respectfully submitted,

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